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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/574,584

04/04/2006

Jussi Tomperi

117373

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7590

05/12/2009

OLIFF & BERRIDGE, PLC

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ALEXANDRIA, VA 22320-4850

EXAMINER

CORDERO GARCIA, MARCELA M

ART UNIT

PAPER NUMBER

1654

MAIL DATE

DELIVERY MODE

05/12/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/574,584

Applicant(s)

TOMPERI ET AL.

ExaminerMARCELA M. CORDERO
GARCIA**Art Unit**

1654

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 31-55 is/are pending in the application.
- 4a) Of the above claim(s) 31-43, 52, 53, 55 and 56 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 44, 47-49 and 54 is/are rejected.
- 7) ☒ Claim(s) 45-46, 50 and 51 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 08/06
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: ____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____

DETAILED ACTION

Election/Restrictions

Applicants' election with traverse of Group II, in the reply filed on 13 February 2008 is acknowledged. The traversal is on the ground(s) that there is at least unity of invention with respect to claims 44-55 by the virtue of the fact that the claims of Groups II-IV are directed to a product (a compound of Formula II), a process for making the product (a compound of Formula II) and a process for using the product (Group III as directed to methods of using a compound of Formula II). Applicants submit that the Office Action does not establish that each and every element of claim 44 is known in the prior art. This is not found persuasive because, as set forth below, claim 44 is indeed anticipated by the prior art cited below and therefore the technical feature of Groups II-IV, a composition of Formula II, is known in the art therefore is not a special technical feature. Since no "special" technical feature is present, there is no Unity of Invention.

With respect the election of species requirement Applicants elect compound 17 (described in the table on page 57 of the present specification) with traversal on the ground that nothing in the PCT or its rules permits issuing an election of species requirement. Any United States practice (such as an election of species requirement) or interpretation of the rule which is different from or in addition to the unity of practice as delineated in PCT Unity Rules 13.1-13.4 and is contrary to PCT Article 27 and the present election of species requirement is accordingly prohibited by Article 27. Applicants' arguments have been carefully considered but not deemed persuasive for the reasons of record and by the contents of MPEP 1893.03(d) Unity of Invention [R-7]

which describe the proper use of election of species within the context of national stage PCT applications.

The requirement is still deemed proper and is therefore made FINAL.

Claims 31-56 are pending in the application. Claims 31-43, 52-53 and 55-56 are withdrawn as not drawn to the elected group/species. Claims 44-51 and 54 are presented for examination on the merits.

The elected compound 17 was searched and found free of the prior art. The search was extended to the compounds in claim 51 and such compounds were also found free of the prior art. Therefore the search was broadened again and a species encompassed by the instant claims was found and examined, as set forth below.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 44, 47-49 and 54 are rejected under 35 U.S.C. 102(b) as being anticipated by Okamoto et al. (EP 0 183 271, citation 10 in the IDS of 08/06).

Okamoto et al. teach a compound of Formula II or a pharmaceutically acceptable salt or ester thereof, e.g., compound 13, page 9, wherein Q is aryl substituted with Ra, wherein Ra is ORb, Rb = (C1)alkyl (CH3); A is H, B is H, n=3, D is naphthyl (L, X are CR6, R6 is H), R2 are both H. See also compound 23, page 11. See also claims.

Therefore the reference is deemed to anticipate the instant claims above.

Claim Objections

Claims 45-46 and 50-51 are objected to as being dependent upon a rejected base claim.

Conclusion

No claim is allowed.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARCELA M. CORDERO GARCIA whose telephone number is (571)272-2939. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia J. Tsang can be reached on (571) 272-0562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Anish Gupta/
Primary Examiner, Art Unit 1654

/Marcela M Cordero Garcia/
Examiner, Art Unit 1654

MMCG 05/09